



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,257	02/28/2005	Vincent Moreau	1204.1110101	7062

7590 01/02/2008
David M Crompton
Crompton Seager & Tufte
1221 Nicollet Avenue
Suite 800
Minneapolis, MN 55403-2420

EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT	PAPER NUMBER
----------	--------------

4175

MAIL DATE	DELIVERY MODE
-----------	---------------

01/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,257	Applicant(s) MOREAU, VINCENT	
	Examiner KYLE R. GRABOWSKI	Art Unit 4175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/28/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/28/05, 01/13/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 10, and 12-13, are rejected under 35 U.S.C. 102(b) as being anticipated by Herrmann et al. (US 2002/0030360).

In respect to claims 1-4 and 6, Herrmann et al. disclose: a value-bearing document 1 comprising a paper substrate 2 with a zone of reduced thickness - depression 8 and window opening 4; a strip of cover foil 5, reinforcing means, which “adheres firmly to the surface 6 of the carrier 2 around the opening 4 in the regions 7” (0032, Fig. 2) covering the zone of reduced thickness, 4 and 8, on the top of the paper substrate 2; the cover foil 5 comprising a carrier film 15 which also covers the zone of reduced thickness, 4 and 8; the carrier film 15 is “perfectly transparent” and made of polyester or polycarbonate (0054, Fig. 2); the cover foil 5 comprises an additional security feature 13 (0037, Fig. 1).

In respect to claims 10 and 12-13, Herrmann et al. inherently disclose the claimed subject matter for the reasons stated above including a process of producing a

banknote with a zone of reduced thickness forming a window and covering the zone with reinforcing means (a strip or patch of material) and further including an additional security feature. The end product disclosed in Herrmann et al. inherently discloses these steps.

3. Claims 1, 3, 5, 7, 8, 10, and 11, are rejected under 35 U.S.C. 102(e) as being anticipated by Keller et al. (US 2005/0104364).

In respect to claims 1, 3, 5, 7, and 8, Keller et al. disclose: a security substrate paper 1, with a zone of reduced thickness - depression 5 and window opening 2; a strip of material, security element 3, covers and reinforces the zone of reduced thickness (Fig. 2); the security element 3, also a 'patch' which covers and reinforces the zone of reduced thickness, comprises an optically variable element (Abstract) which utilizes an similar layers 6 and 7 that include metal layers 12 and 13 with interruptions 16 and 18, caused by "laser removal, etching or washing" (0047, Fig. 3); Figure 13 shows that two security elements 27 and 28, corresponding to the elements 6 and 7 (0068) of to the aforementioned security element 3, can be placed on both sides of the paper substrate 1. In respect to claim 8, the security elements 27 and 28 are broadly both a "strip" and a "patch" and therefore Figure 13 discloses all of the claimed subject matter for the reasons stated above.

In respect to claims 10 and 11, Keller et al. inherently disclose the claimed subject matter for the reasons stated above including: a process of producing a

Art Unit: 4175

banknote with a zone of reduced thickness forming a window and covering the zone with reinforcing means (a strip or patch of material) on each side of the security substrate. The end product disclosed in Keller et al. inherently discloses these steps.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herrmann et al. (US 2002/0030360) in view of the application's admission of prior art. Herrmann does not disclose a sheet comprising a plurality of value-bearing documents (notes) however the applicant discloses "a plurality of notes placed in successive rows and columns, as it is done in a *known fashion* for banknotes" (Pg. 7, Para 4). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to

provide the value-bearing documents taught in Herrmann et al. in a multiple array in view of the disclosure in the present application of admitted prior art to incorporate the security features economically onto one single sheet to be later cut into individual notes.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hardwick et al. (US 6,471,247), Heim (US 2005/0127663), and Farber (US 6,036,230), disclose similar inventions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Grabowski whose telephone number is (571) 270-3518. The examiner can normally be reached Monday through Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrence R. Till can be reached at (571) 272-1280.

/Terrence R Till/

Supervisory Patent Examiner, Art Unit 4175

/Kyle R Grabowski/
Examiner, Art Unit 4175